

ESTTA Tracking number: **ESTTA517921**

Filing date: **01/24/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91208855
Party	Defendant THE WINE GROUP LLC
Correspondence Address	DIJANA KRISTO THE WINE GROUP LLC 4596 S TRACY BLVD TRACY, CA 95377-8106 DIJANA.KRISTO@THEWINEGROUP.COM;JOHN.SUT
Submission	Answer and Counterclaim
Filer's Name	Paul W. Reidl
Filer's e-mail	paul@reidllaw.com
Signature	/pwr/
Date	01/24/2013
Attachments	Bourbon Opposition.pdf (4 pages)(40273 bytes)

Registration Subject to the filing

Registration No	4178113	Registration date	07/24/2012
Registrant	Greater Louisville Convention & Visitors Bureau 401 W. Main St. Suite 2300 Louisville, KY 40202 UNITED STATES		

Goods/Services Subject to the filing

Class 035. First Use: 2011/10/20 First Use In Commerce: 2011/10/20
All goods and services in the class are requested, namely: Chamber of commerce services, namely, promoting business and tourism in the Kentucky bourbon-producing area

1 **BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE**
2 **TRADEMARK TRIAL AND APPEAL BOARD**

3
4 Application Serial No. 85/736,374

5 Mark: (B)URBAN

6 Class: 33

7
8 **GREATER LOUISVILLE**
9 **CONVENTION & VISITORS**
10 **BUREAU,**

11 Opposer,

12 v.

13 **THE WINE GROUP, LLC.,**

14 Applicant.

Opposition No: 91208855

ANSWER AND COUNTERCLAIM

15 Applicant through its counsel hereby answers and counterclaims as follows:

16 **ANSWER**

17 1. The allegations of Paragraph 1 of the Notice of Opposition are admitted.

18 2. Applicant has no basis for admitting or denying the allegation that Opposer has
19 any interest, let alone an enforceable one, in registration no. 3,932,986, and therefore that
20 allegation in Paragraph 2 of the Notice of Opposition is denied. The remaining allegations of
21 Paragraph 2 of the Notice of Opposition are admitted but only to the extent that Opposer appears
22 on the USPTO docket as the record owner of the cited marks..

23 3. The allegations of Paragraph 3 of the Notice of Opposition are denied.

24 4. The allegations of Paragraph 4 of the Notice of Opposition are denied.

1 5. The allegations of Paragraph 5 of the Notice of Opposition are denied.

2 6. The allegations of Paragraph 6 of the Notice of Opposition are admitted.

3 7. Applicant admits that the goods specified in its application are bourbon, but
4 denies the remaining allegations in Paragraph 7 of the Notice of Opposition.

5 8. The allegations of Paragraph 8 of the Notice of Opposition are denied.

6 **AFFIRMATIVE DEFENSES**

7 1. Opposer has no standing to raise claims based on Registration No. 3,932,986.

8 2. The mark contained in registration no. 3,932,986 is invalid because, on
9 information and belief, it was assigned without any tangible goodwill and licensed back without
10 any meaningful quality control.

11 **COUNTERCLAIM FOR CANCELLATION**

12 For its counterclaim, Applicant alleges as follows:

13 1. Applicant owns application no. 85/736,374.

14 2. Opposer has filed opposition no. 91208855 against application no. 85/736,374,
15 claiming that it is likely to cause confusion with registration no. 4,178,113.

16 3. On information and belief, Opposer has never used registered mark no. 4,178,113
17 in connection with the services specified therein, it was not in use at the time it filed the
18 specimen of use, it was not in use at the time of the registration and it is not in use now.
19 Opposer's registration no. 4,178,113 should therefore be cancelled pursuant to 15 U.S.C. § 1064
20 because it is void *ab initio* and has otherwise been abandoned.

21 4. On information and belief, Opposer did not at the time it filed the application to
22 register the mark set forth in registration no. 4,178,113 have a bone fide intention to use the mark
23
24

1 in connection with the services specified therein, and therefore it should be cancelled pursuant to
2 15 U.S.C. § 1064 because it is void *ab initio*.

3 5. On information and belief, to the extent that Opposer authorized a third party such
4 as the Kentucky Derby Museum to use the mark set forth in registration no. 4,178,113 it did not
5 exercise quality control over the services and therefore the registered mark has been abandoned
6 due to naked licensing.

7 **WHEREFORE**, Opposer respectfully requests that the petition for cancellation be
8 granted and that registration no. 4,178,113 be cancelled. The \$300 fee has been paid at the time
9 of this filing.

10 Respectfully submitted,

11 **LAW OFFICE OF PAUL W. REIDL**

12 

13 By: _____

14
15 Dated: January 24, 2013

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23 *Attorney for Applicant,*
24 *The Wine Group*

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on Opposer by placing a true copy thereof in the United States mail enclosed in an envelope, postage prepaid, addressed as follows to their counsel of record at his present business address:

John A. Galbreath
Galbreath Law Offices
2516 Chestnut Woods Ct.
Reiseterstown, MD 21136-5523

James Beid.